

REMARKS

In the Final Office Action mailed August 2, 2010 the Examiner rejected Claims 1-3, 5-14 and 16-21 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publication No. 2004/0122335 (hereinafter, “the Sackellares application), and rejected Claims 4 and 15 under 35 U.S.C. §103(a) as being obvious in light of the Sackerelles application and U.S. Patent Application Publication No. 2003/0195602 (hereinafter, “the Boling application). Each rejection is addressed below.

I. Rejection of Claims 1-3, 5-14 and 16-21 under 35 U.S.C. §102(b)

The Examiner rejected Claims 1-3, 5-14 and 16-21 under 35 U.S.C. §102(e) as being anticipated by the Sackerelles application. The Applicants submit, however, that the Sackerelles patent application is not prior art.

Specifically, attached to this communication (at TAB A) are signed Declarations by the Inventors Dr. Robert Savit, Dr. Ivo Drury, Dr. Dingzhou Li, and Dr. Weiping Zhou under 37 C.F.R. §1.131 and supporting evidence at TAB B and TAB C indicating conception and reduction to practice of the presently claimed invention 1) prior to the August 27, 2003 filing date for the Sackerelles patent application, and 2) prior to the August 27, 2002 filing date for U.S. Provisional Patent Application Serial No. 60/406,063 for which the Sackerelles patent application claims priority.

The supporting evidence at TAB B is an empirical publication (Li, Dingzhou, Zhou, Weiping, Drury, Ivo, and Savit, Robert (2003) Mathematical Biosciences 186 pages 63-77) (hereinafter, “the Li publication”). The signed Declarations by the Inventors Dr. Robert Savit, Dr. Ivo Drury, Dr. Dingzhou Li, and Dr. Weiping Zhou under 37 C.F.R. §1.131 assert that the work presented in the Li publication was performed in this country by each of the Inventors prior to August 27, 2002. The signed Declarations by the Inventors Dr. Robert Savit, Dr. Ivo Drury, Dr. Dingzhou Li, and Dr. Weiping Zhou under 37 C.F.R. §1.131 assert that, as evidenced on page 63 of the Li publication, the work presented in the Li publication was submitted to the Mathematical Biosciences journal on July 25, 2002. The signed Declarations by the Inventors Dr. Robert Savit, Dr. Ivo Drury, Dr. Dingzhou Li, and Dr. Weiping Zhou under 37 C.F.R. §1.131 assert that, as

evidenced by the work shown at in the Li publication, the mathematical considerations and experimental results used in obtaining the claimed invention are described. The signed Declarations by the Inventors Dr. Robert Savit, Dr. Ivo Drury, Dr. Dingzhou Li, and Dr. Weiping Zhou under 37 C.F.R. §1.131 assert that the work shown in the Li publication is represented in the present application at, for example, paragraphs 0092 through 0098, and Examples I, II, and III (paragraphs 0112 through 00149), and Figures 1-9.

The supporting evidence at TAB C was submitted by the Inventors to the University of Michigan Technology Transfer on June 20, 2002.¹ The signed Declarations by the Inventors Dr. Robert Savit, Dr. Ivo Drury, Dr. Dingzhou Li, and Dr. Weiping Zhou under 37 C.F.R. §1.131 assert that the work presented at TAB C was performed in this country by me or under my supervision, prior to August 27, 2002, and was submitted to the University of Michigan Technology Transfer on June 20, 2002.

In addition, the signed Declarations by the Inventors Dr. Robert Savit, Dr. Ivo Drury, Dr. Dingzhou Li, and Dr. Weiping Zhou under 37 C.F.R. §1.131 indicate that upon submitting the Invention Disclosure shown at TAB C to the University of Michigan Technology Transfer on June 20, 2002, each inventor worked diligently with the University of Michigan Technology Transfer and the patent attorneys representing the University of Michigan Technology Transfer in preparing and filing the patent

¹ The Applicants note that the supporting evidence provided in TAB C was initially submitted as supporting evidence for the signed Declarations by the Inventors Dr. Robert Savit, Dr. Ivo Drury, Dr. Dingzhou Li, and Dr. Weiping Zhou under 37 C.F.R. §1.131 submitted to the US Patent Office on June 3, 2010. The June 3, 2010 signed Declarations by the Inventors Dr. Robert Savit, Dr. Ivo Drury, Dr. Dingzhou Li, and Dr. Weiping Zhou under 37 C.F.R. §1.131 assert, as evidenced by the work shown at TAB C (TAB B in the June 3, 2010 Declarations), reduction to practice in the United States of America the presently claimed invention prior to the filing date of the Sackerelles patent application, and prior to the filing date of the Sackerelles provisional patent application. In addition, the June 3, 2010 signed Declarations by the Inventors Dr. Robert Savit, Dr. Ivo Drury, Dr. Dingzhou Li, and Dr. Weiping Zhou under 37 C.F.R. §1.131 assert that the work shown at TAB C (TAB B in the June 3, 2010 Declarations) was performed in this country prior to August 27, 2002. In addition, the June 3, 2010 signed Declarations by the Inventors Dr. Robert Savit, Dr. Ivo Drury, Dr. Dingzhou Li, and Dr. Weiping Zhou under 37 C.F.R. §1.131 assert that, as evidenced by the work shown at TAB C (TAB B in the June 3, 2010 Declarations), the mathematical considerations and experimental results used in obtaining the claimed invention are described. In addition, the June 3, 2010 signed Declarations by the Inventors Dr. Robert Savit, Dr. Ivo Drury, Dr. Dingzhou Li, and Dr. Weiping Zhou under 37 C.F.R. §1.131 assert that the work shown at TAB C (TAB B in the June 3, 2010 Declarations) is represented in the present application at, for example, paragraphs 0092 through 0098, and Examples I, II, and III (paragraphs 0112 through 00149), and Figures 1-9.

application for which the present patent application claims priority (U.S. Provisional Patent Application Serial No. 60/410,695 filed September 13, 2002).²

As the Sackerelles patent application and the patent application for which it claims priority are not prior art against the present application, the Applicants respectfully request withdrawal of the respective rejections.

II. Rejection of Claims 4 and 15 under 35 U.S.C. §103(a)

The Examiner rejected Claims 4 and 15 were rejected as being obvious in light of the Sackerelles application and the Boling application. Claims 4 and 15 are dependent upon non-obvious and non-anticipated Claims 1 and 12. As discussed in Section I of this Office Action Response, the Sackerelles application is not prior art against the current application. The Boling application fails to remedy this deficiency. As such, a *prima facie* case of obviousness has not been established. The Applicants request these rejections be withdrawn.

² The Applicants note that in the August 2, 2010 Final Office Action, the Examiner rejected the signed Declarations by the Inventors Dr. Robert Savit, Dr. Ivo Drury, Dr. Dingzhou Li, and Dr. Weiping Zhou under 37 C.F.R. §1.131 submitted to the US Patent Office on June 3, 2010 for, "...not providing any support for reasonable diligence as required by MPEP 715.07 III...[which] requires some evidence of facts establishing diligence. The absence of any dates in the present affidavit makes it impossible to establish diligence between the reduction to practice and the filing." The signed Declarations by the Inventors Dr. Robert Savit, Dr. Ivo Drury, Dr. Dingzhou Li, and Dr. Weiping Zhou under 37 C.F.R. §1.131 submitted with this Response provide the following dates: submission of the work shown in TAB B to the Mathematical Biosciences journal on July 25, 2002, and submission of the work shown in TAB C to the University of Michigan Technology Transfer on June 20, 2002.

III. Conclusion

All grounds of rejection of the Final Office Action of August 2, 2010, have been addressed and reconsideration of the application is respectfully requested. Should the Examiner believe that a telephone interview would aid in the prosecution of this application Applicant encourages the Examiner to call the undersigned collect at (608) 662-1277.

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/Robert A. Goetz/

Robert A. Goetz
Registration No. 55,210
CASIMIR JONES, SC
2275 Deming Way, Suite 310
Middleton, WI 53562
608.662.1277